

S/N 10/018,237

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants: Christian Hogl et al.

Examiner: Ojo Oyebisi

Serial No.: 10/018,237

Group Art Unit: 3696

Filed: June 24, 2002

Docket No.: 2043.184US1

Customer No.: 49845

Confirmation No.: 8864

Title: METHOD FOR TRANSMITTING A CODE

APPELLANTS REPLY BRIEF UNDER 37 C.F.R. § 41.41

Mail Stop Appeal Brief - Patents

Commissioner for Patents

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REMARKS

A) Renner/Taskett Combination Does Not Disclose Each Element of Claims 1, 12, 23, and 24

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness.¹ To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art.² Thus, unless it is shown that the proposed combination of the cited documents relied upon by the Examiner for obviousness rejections, namely Renner and Taskett, discloses or suggests all elements of a claim, the claim is patentable in view of Renner and Taskett.

Claim 1 recites "receiving financial account identifier information of a user at a code allocation unit" and "from the code allocation unit, effecting a value transfer utilizing the financial account identifier information and the access code." As the determination of obviousness is to be made based on the subject matter as a whole,³ claim 1 requires a "financial account identifier information" that is received at the code allocation unit, and that is also utilized for effecting a value transfer from the code allocating unit. In order to show the "financial account identifier information" in the operation of "receiving financial account identifier information .. at a code allocation unit" recited in claim 1, the Examiner cites a stored value account number (SVAN) of Renner and notes that a stored value account number (SVAN) is akin to a financial account identifier recited in claim 1 and that the stored value server in Renner is akin to the code allocation unit.⁴

In order to show "from the code allocation unit, effecting a value transfer utilizing the financial account identifier information and the access code," the Examiner refers to the verification process in Renner where the stored value server, in response to a verification request, verifies the balance certificate and verifies that the SVAN from the card exists in the

¹ *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988).

² *In re Royka*, 490 F.2d 981 (CCPA 1974).

³ 35 U.S.C. §103(a).

⁴ Examiner's Answer, page 3, lines 5-7. (Examiner states that a stored value account number (SVAN) is akin to a "financial account identifier" recited in claim 1.)

database and that the accumulated balance is not less than zero.⁵ In the "Response to Argument" section, the Examiner states that, "in Renner, the cardholder uses his PIN (i.e., access code) and stored value account number /SVAN (i.e., financial account identifier information) to carry out a value transfer."⁶ It is submitted that while a cardholder in Renner uses a PIN and a SVAN to carry out a transaction, this does not indicate that a value transfer is effected "from the code allocation unit," as required by claim 1. The Examiner further asserts that a funds transfer operation is the same as validation and authentication.⁷ It is submitted that while the operations of validation and authentication may be performed prior to a funds transfer, neither a validation nor an authentication operation is equivalent to the operation of transferring funds. Still further, the Examiner refers to the steps of the funds transfer operation involving encrypting SVAN and the PIN and states that these operations are akin to effecting a value transfer utilizing the financial account identifier information and the access code.⁸ It is respectfully pointed out that not only the steps of encrypting SVAN and the PIN are different from an operation of "effecting a value transfer" recited in claim 1, but also that Renner does not disclose or suggest that suggest that the steps of encrypting SVAN and the PIN are performed at the stored value server (correlated by the Examiner with "the code allocation unit" of claim 1). Thus, Renner clearly does not contemplate value transfers effected from the stored value server and thus fails to disclose or suggest "from the code allocation unit, effecting a value transfer utilizing the financial account identifier information and the access code," as recited in claim 1. Taskett, describing a refundable prepaid telephone card,⁹ whether considered separately or in combination with Renner, also fails to disclose or suggest these features of claim 1.

The Examiner correctly stated that Renner fails to disclose or suggest "the access code being reflected in an amount of value associated with the value transfer so as to be transmitted to the user together with a receipt for the value transfer" recited in claim 1. The Examiner cites Taskett to show this feature. Specifically, the Examiner refers to the description in Taskett where, upon receipt of the ID number associated with a prepaid phone card account, the service provider host computer interrogates its database to determine whether sufficient funds" exist in

⁵ Renner, page 22, lines 3-12.

⁶ Examiner's Answer, page 10.

⁷ Examiner's Answer, page 10 ("funds transfer operation (i.e., validation and authentication)").

⁸ Examiner's Answer, page 10.

the account to permit the consumer to make a long distance call. If not, the consumer is informed that his account is fully withdrawn, and invited to purchase a new prepaid card or make other arrangements for paying the long distance charges for this particular call. If the prepaid account has sufficient funds available to permit a long distance call, the consumer enters the telephone number of his desired destination and is then be connected to his destination, and will be permitted to engage in his long distance telephone call until the available funds in his account are depleted.¹⁰

Taskett, while referring to funds being available to permit a long distance call, makes no mention of a value transfer or of an amount associated with a value transfer. Furthermore, it is not contemplated in Taskett that the ID number may be in any way reflected in an amount of value associated with a value transfer. The Examiner explains that, because the ID number in Taskett is used to determine whether sufficient funds exist in the associated prepaid telephone account, the ID number is associated with the balance/value of the account.¹¹ While the ID number in Taskett may be used to determine the balance of the associated prepaid telephone account, an ID being "*associated*" with certain data is distinct from a code "*being reflected* in an amount of value." Thus, Taskett, whether considered separately or in combination with Renner, fails to disclose or suggest "the access code being reflected in an amount of value associated with the value transfer so as to be transmitted to the user together with a receipt for the value transfer," as recited in claim 1.

Because the combination of Renner and Taskett does not teach all limitations of claim 1, the Examiner failed to establish *prima facie* obviousness of claim 1. It is respectfully requested that the rejection be reversed.

Claims 12, 23, and 24 are patentable and should be allowed for at least the reasons articulated above. It is respectfully requested that the rejection be reversed.

B) Renner/Taskett Combination Does Not Disclose Each Element of Claim 3

Claim 3 recites "wherein the generated access code is equal to the amount of money

⁹Taskett, Abstract.

¹⁰Taskett, page 7, lines 13-24.

associated with the value transfer." In order to show this feature, the Examiner cites a unique ID code in Tuskett for accessing a prepaid telephone account service provider network. The position taken by the Examiner appears to be (see page 3 of the Detailed Action) that because the ID number in Tuskett can be used to determine whether sufficient funds exist in the account, the ID number may be considered as being equal to the amount of money associated with the value transfer. The reasoning behind this conclusion is unclear. A code that is associated with a certain value does not have to be equal to that value (e.g., consider a part number "12345" associated with a price being "\$1.99.") Thus, while claim 3 is allowable by virtue of being dependent on allowable claim 1, claim 3 is patentable in view of the Renner/Taskett combination because said combination fails to disclose or suggest "wherein the generated access code is equal to the amount of money associated with the value transfer," recited in claim 3. Thus, while claim 3 is allowable by virtue of being dependent on allowable claim 1, claim 3 is patentable in view of the Renner/Taskett combination also because said combination fails to disclose or suggest "wherein the generated access code is equal to the amount of money associated with the value transfer," recited in claim 3. It is respectfully requested that the rejection be reversed.

C) Renner/Taskett Combination Does Not Disclose Each Element of Claim 8

Regarding claim 8, it has been explained in the previous response that because two distinct and complete codes (ID code and replacement code) discussed in Taskett cannot be regarded as corresponding to an access code comprising two partial codes, Taskett fails to disclose or suggest "wherein: the access code comprises at least two partial codes," recited in claim 8. In the "Response to Arguments" section on page 11 of the Examiner's Answer, the Examiner states that this argument is moot "because the applicant fails to incorporate into the claim language that the two partial codes are not distinct and are meant to be used for the same purpose." Claim 8, however, requires that the two partial codes make up an access code (or a portion of an access code), which requirement is expressed in claim 8 as "the access code comprises at least two partial codes." Claim 8 also requires that the access code comprising two partial codes is "reflected in an amount of value associated with the value transfer," by virtue of claim 8 being dependent on claim 1. Because ID code and replacement code discussed in

¹¹ Final Office Action, Detailed Action, pages 8-9.

Taskett cannot be viewed as making up an access code (or a portion of an access code), that is reflected in an amount of value associated with the value transfer, Taskett, whether considered separately or in combination with Renner fails to disclose or suggest "the access code comprises at least two partial codes" as recited in claim 8.

Thus, while claim 8 is allowable by virtue of being dependent on allowable claim 1, claim 8 is patentable in view of the Renner/Taskett combination also because said combination fails to disclose or suggest "wherein: the access code comprises at least two partial codes," recited in claim 8. It is respectfully requested that the rejection be reversed.

D) Renner Teaches Away From the Subject Matter of Claims 1, 12, 23, and 24

35 U.S.C. §103(a) prescribes that the determination of obviousness is made based on the subject matter as a whole. In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.¹² A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.¹³

The subject matter claimed in claim 1 includes "receiving financial account identifier information of a user" and "effecting a value transfer utilizing the financial account identifier information and the access code." Applicant can rebut a presumption of obviousness by showing that the prior art teaches away from the claimed invention.¹⁴ Thus, if Renner, relied upon by Examiner to show obviousness of claim 1, teaches away from the claimed invention, the rejection should be deemed to have been successfully rebutted.

In order to show a "financial account identifier" recited in claim 1, Examiner cites a stored value account number (SVAN) discussed in Renner.¹⁵ In Renner, the SVANs are created as a function of respective unique smart card identifiers, such that the account associated with a smart card is

¹² Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); Schenck v. Nortron Corp., 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983).

¹³ W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

¹⁴ Iron Grip Barbell Co., Inc. v. USA Sports, Inc., 392 F.3d 1317, 1322, 73 USPQ2d 1225, 1228 (Fed. Cir. 2004).

¹⁵ Examiner's Answer, page 3.

not directly traceable to any particular cardholder.¹⁶ Because a SVAN is not directly traceable to any particular cardholder, a SVAN in Renner is distinct from and even teaches away from a "financial account identifier information *of a user*," as recited in claim 1. Thus, Renner teaches away from a "financial account identifier information *of a user*," as recited in claim 1, which also shows that Examiner failed to provide a reasoned rationale for obviousness in view of Renner and therefore failed to make a *prima facie* showing of obviousness. It is respectfully requested that the rejections in view of the combination of Renner with Taskett be reversed.

¹⁶ Renner, page 5, lines 15-21.

CONCLUSION

The reasons argued above are summarized as follows. First, Renner and Taskett fail to disclose or suggest every element recited in independent claims 1, 12, 23, and 24. Second, Renner and Taskett fail to disclose or suggest every element recited in dependent claim 3. Third, Renner and Taskett fail to disclose or suggest every element recited in dependent claim 8. Fourth, Renner teaches away from the invention of claims 1, 12, 23, and 24. For the reasons articulated above, with respect to claims 1-24, the Examiner failed to make prima facie showing of obviousness under 35 USC § 103(a) in view of the combination of Renner and Taskett. It is respectfully submitted that the art cited does not render the claims 1-24 obvious and that the claims are patentable over the cited art. Reversal of the rejection and allowance of the pending claims are respectfully requested.

Appellants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Appellants' representative at (408) 278-4052 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account 19-0743.

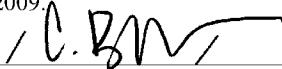
Respectfully submitted,

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